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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,007	05/05/2004	Fen-Chung Kung	1999-0299CON	7666
7590	08/01/2006		EXAMINER DUONG, FRANK	
Samuel H. Dworesky AT&T Corp. Post Office Box 4110 Middletown, NJ 07748			ART UNIT 2616	PAPER NUMBER

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/840,007

Applicant(s)

KUNG ET AL.

Examiner

Frank Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 1954 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is a response to communications dated 05/05/04. Claims 1-17 are pending in the application.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: coupling the terminals together via said least cost alternative network resources for communication according to said default quality of service; and billing the call after the termination of the connection. In other words, the claim has no post solution of "billing" a user after the termination of the connection. Thus, claim 1 calls for an incomplete invention without additional steps of claims 2-3. It is reminded that Applicants are entitled to claim a broad invention, not an incomplete invention.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 and 15-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-6 and 13-15 of U.S. Patent No. 6,775,267. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3-6 and 13-15 of the '267 patent teach essentially the same steps as claims 1-17 of the instant application. Even though claims 1-17 of the instant application are broadened by omitting certain limitations (*i.e.*, "*coupling said first ... billing for said call ... of the communication*" in claim 1, and "*receiving default quality of service ... by a user*" in claim 15), it has been held that the omissions of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be an obvious variation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chau et al (USP 5,187,710) (hereinafter "Chau") in view of Rupp et al (*INDEX: A Platform for determining how People Value the Quality of their Internet Access, IEEE, pages 1-7, May 1998*) (hereinafter "Rupp").

Regarding **claim 14**, in accordance with Chau reference entirety, Chau discloses a method for billing for value-added communications calls, comprising, among other things, the step of changing billing parameters during a call in real time in response to user inputs (see '710, col. 2, lines 28-30 and thereafter). Chau fails to disclose the user inputs including user requested changes in quality of service, changes in data rate and changes in preferred service provider. However, such limitation lacks thereof from Chau reference is well known and taught by Rupp.

In accordance with Rupp reference entirety, Rupp teaches Internet Demand Experiment (INDEX), a locally developed system for user interaction and metering individual subject usage, comprising, among other things, a java application running on user's computer enables the users to select different QoS and price and control their usage of the network resources during an active session (see *Rupp, page 3, section 2.2, lines 1-11*) to provide an appropriate pricing structures for each segment of the internet and for further proliferation of the internet services (see *Rupp reference, page 2, right col., lines 8-10*). The "price" is inherently corresponding to the "data rate" and

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“service provider” (see *Altmann document, section 2.1, accompanied this Office Action for Examiner’s position*).

Thus, it would have been obvious to those skilled in the art at the time of the invention was made to implement or incorporate Rupp’s application into Chau’s method to arrive the claimed invention with a motivation to an appropriate pricing structures for each segment of the internet and for further proliferation of the internet services (see *Rupp reference, page 2, right col., lines 8-10*).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

Altmann et al, INDEX Project: User Support for buying QoS with regard to user’s preferences, IEEE, pages 101-104, 1998.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Frank Duong', with a stylized flourish at the end.

**FRANK DUONG  
PRIMARY EXAMINER**

July 14, 2006